



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,718	10/26/2006	Robert Kenneth Oram	Weitzel 348	6802
7590 Michael Y. Epstein 1551 Ben Sawyer Blvd #5A Mt Pleasant, SC 29464			EXAMINER BASINGER, SHERMAN D	
			ART UNIT 3617	PAPER NUMBER < >
			MAIL DATE 08/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/552,718		ORAM ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sherman D. Basinger		3617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because legal phraseology has been used therein. Correction is required. See MPEP § 608.01(b).
2. A copy of CB 01 30 452.6 (discussed on page 10 of the specification) is requested as it is not readily available to the examiner.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. Claim 9 is an omnibus type claim.
5. Claim 10 provides for the use of a clamp, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3617

7. Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Daghe et al.

1. A clamp 10 for securing to a pipe or flowline for mounting buoyancy thereon, the clamp comprising:

- i) a clamp body 12 having surfaces against which buoyancy may abut
- ii) means 24 for urging the clamp towards the pipe, and
- iii) a radially resilient member G capable of expanding or contracting to conform to changes in diameter of the pipe.

For claim 3 and 4, note column 5, lines 29-35.

Note that “for securing to a pipe or flowline for mounting buoyancy thereon” is an intended use of the clamp. An apparatus claim must differ from the prior art by structure

Art Unit: 3617

as opposed to intended use. So long as the clamp of Daghe et al can be used to perform the intended use, the intended use does not lend patentability to the claim.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 286 649 in view of Daghe et al.

GB 649 discloses a clamp for securing to a pipe or flowline for mounting buoyancy thereon, the clamp comprising:

- i) a clamp body 2, 2' having surfaces against which buoyancy may abut and
- ii) means 7 for urging the clamp towards the pipe.

GB 649 does not disclose a radially resilient member capable of expanding or contracting to conform to changes in diameter of the pipe.

Note the gasket member G of Daghe et al adhesively attached to the band 12. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adhesively attach a gasket member similar to that of Daghe et al to the band of GB 649. A reason to do so is to protect the body 2, 2' from the band as the body is made of glass reinforced plastic.

As such, the gasket member provided to GB 649 would be a radially resilient material which lies intermediate the means for urging the clamp towards the pipe 7 and the clamp body 2,2'.

It would further have been obvious to make the radially resilient material from a polymeric material which comprises compounded natural or synthetic rubber in view of column 5, lines 29-35 of Daghe et al.

When provided between the body 2,2' and the band 7 of GB 649, the radially resilient material will be spaced apart from adjacent material to which it is not bonded at a

Art Unit: 3617

plurality of locations.

GB 649 anticipates the clamp body comprising a fiber reinforced plastics material. wherein the fiber reinforced, plastics material comprises a thermosetting resin comprising epoxy, polyester, vinyl ester or mixtures thereof reinforced by fiber of one or more of glass, carbon or metal.

The means for urging 7 of GB 649 is Kevlar or titanium.

For claim 11 GB 649 discloses a method of mounting buoyancy on a pipe or flowline, the method comprising the steps of:

- a) mounting a clamp comprising
  - i) a clamp body 2,2' having surfaces against which buoyancy may abut,
  - ii) means 7 for urging the clamp body towards the pipe,
- b) urging the clamp body towards the pipe and
- c) mounting buoyancy on the clamp body.

GB 649 does not disclose a radially resilient member capable of expanding or contracting to conform to changes in diameter of the pipe about the pipe.

Note the gasket member G of Daghe et al adhesively attached to the band 12. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adhesively attach a gasket member similar to that of Daghe et al to the band 7 of GB 649. A reason to do so is to protect the body 2, 2' from the band as the body is made of glass reinforced plastic.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tessier et al is cited to show the clamp for a cylindrical object in which the clamp is formed of fibers.

Art Unit: 3617

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 571-272-6679. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sherman Basinger/  
Sherman Basinger, PE  
Art Unit 3617

8/1/07